

REMARKS

Claims 10, 11 and 179-186 are pending in the application. By this amendment, claims 180 and 183-186 are cancelled and new claims 187-196 are added. Following entry of this amendment, claims 10, 11, 179, 181-182 and 187-196 will be pending. No new matter is added by this amendment. Support for the new claims is found throughout the specification and originally filed claims, including, e.g., at page 94, lines 15-16; page 76, line 33; Figures 4A-4D; page 6, line 37-38; page 96, lines 7-13; page 78, line 16; Figures 9A-9D; page 75, lines 16-17, and original claims 3, 7, and 8. The specification is amended to amend the title, add SEQ ID NOs, correct minor typographical errors, to delete references to the Figures, and to incorporate the sequence listing submitted herewith into the specification. Entry of this amendment is respectfully requested.

Applicants note that the listing of the claims provided in the amendment filed July 5, 2006 inadvertently (i) did not include cancelled claims 12-178 (cancelled in the preliminary amendment dated December 3, 2004), and (ii) mis-numbered the new claims added in that amendment as new claims 12-19, rather than new claims 179-186. As helpfully suggested by the Examiner after a teleconference on November 8, 2006, the present listing of the claims (a) shows the correct status of claims 12-178 (cancelled) and (ii) renumbers claims 12-19 added in the amendment filed July 5, 2006 as claims 179-186 as follows:

Claim number in Amendment filed July 5, 2006	Claim number in current Amendment
12	179
13	180
14	181
15	182
16	183
17	184
18	185
19	186

Applicants apologize for any inconvenience to the Examiner due to the misnumbering. In this Amendment, Applicants will describe the rejection using the numbering found in the Office Action, but will also reference the corrected claim numbers for the Examiner's convenience.

With respect to all amendments and cancelled claims, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any objection and/or rejection made by the Office. Applicants expressly reserve the right to pursue prosecution of any subject matter not presently claimed in one or more future or pending continuation and/or divisional applications.

Applicant acknowledge the withdrawal of the rejections under 35 USC §101, §112, first paragraph (written description and enablement), §102 and §103.

Information Disclosure Statements and sequence listing

Applicants thank the Examiner for reviewing and initialing the Form 1449s submitted August 22, 2005, February 24, 2006 and June 29, 2006. A new Information Disclosure Statement is submitted herewith. Review of the references cited and return of an initialed Form 1449 is respectfully requested.

Also submitted herewith is a new computer-readable and text version of the sequence listing, and a statement that the contents of the CRF and text version of the sequence listing are identical. Entry of the sequence listing is respectfully requested. No new matter is added in this sequence listing.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 10-19 (renumbered claims 1, 11, 179-186) are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. Applicants respectfully traverse this rejection for at least the following reasons.

A. Claims 10-19 (renumbered claims 1, 11, 179-186) are rejected on the ground that the phrase "a phenomenon associated with" is allegedly unclear. Applicants respectfully disagree that this phrase is unclear. However, by this amendment, claims 180 and 183-186 (previously numbered 13 and 16-19) are cancelled, and claims 10 and 11 have been amended and use the language kindly suggested by the Examiner. New claim 189 also uses the language suggested by the Examiner. Withdrawal of this rejection is respectfully requested.

B. Claims 10-11 and 19 (renumbered claims 10, 11, and 186) are rejected on the ground that the term "acquires" or "acquiring" allegedly implicates transfer of an already existing "condition" or a "disease" from another. Applicants respectfully disagree that the term "acquires" or "acquiring" implicates transfer of an already existing condition of a disease from another. However, by this amendment, claims 180 and 183-186 (previously numbered 13 and 16-

19) are cancelled, and claims 10 and 11 have been amended and now recite “develop” as suggested by the Examiner. New claim 189 also uses the language suggested by the Examiner. Withdrawal of this rejection is respectfully requested.

C. Claims 10-11 and 19 (renumbered claims 10, 11, and 186) are rejected on the grounds that the phrase “determining the effect of said agent” lacks antecedent basis and is allegedly unclear. Applicants respectfully disagree that this phrase is unclear. However, by this amendment, claims 180 and 183-186 (previously numbered 13 and 16-19) are cancelled, and claims 10 and 11 have been amended and use the language kindly suggested by the Examiner. New claim 189 also uses the language suggested by the Examiner.

D. Claims 10-19 (renumbered claims 1, 11, 179-186) are rejected on the ground that they are allegedly generally narrative and indefinite, failing to conform to current U.S. practice. For the record, Applicants point out that the Examiner has not provided any specific reasons that the claims fail to conform to US practice, aside from pointing out that “the claims are replete with grammatical and idiomatic errors” (Office Action at page 3).

Applicants respectfully traverse this rejection. MPEP § 2173.02 states if the claim language selected by applicants satisfies the statutory requirements of 35 U.S.C. § 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. § 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

Accordingly, Applicants respectfully submit that the present rejection is improper under the MPEP and withdrawal of this rejection is respectfully requested. However, to expedite prosecution, claims 180 and 183-186 (previously numbered 13 and 16-19) are cancelled, and claims 10 and 11 have been amended and use the language suggested by the Examiner, except that the claims have been amended to state “as compared with a control transgenic mouse” in the last clause (rather than “as compared with the control non-transgenic mouse” as suggested by the Examiner) to reflect a more relevant control comparison. New claim 189 uses similar language as amended claims 10 and 11. Withdrawal of this rejection is respectfully requested.

SUMMARY

Applicants believe that this application is now in condition for allowance and respectfully requests that the outstanding rejections be withdrawn and this case passed to issue. The Examiner is invited to contact the undersigned at (650) 467-6222 in order to expedite the resolution of any remaining issues.

In the unlikely event that this document is separated from the transmittal letter or if fees are required, applicants petition the Commissioner to authorize charging our Deposit Account 07-0630 for any fees required or credits due and any extensions of time necessary to maintain the pendency of this application.

Respectfully submitted,
GENENTECH, INC.

Date: 3-27-07

By: Cara Coburn
Cara Coburn
Reg. No. 46,631
Telephone No. (650) 467-6222